REMARKS

I. Introduction

With the addition of new claim 28, claims 14 to 28 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicant notes with appreciation the acknowledgment of the claim for foreign priority and the indication that all copies of the certified copies of the priority documents have been received.

Applicant thanks the Examiner for considering the previously filed Information Disclosure Statement, PTO-1449 paper and cited references.

II. Rejection of Claims 14 to 27 Under 35 U.S.C. § 112, Second Paragraph

Regarding the rejection of claims 14 to 27 under 35 U.S.C. § 112, second paragraph, the Examiner will note that claim 14 has been amended herein without prejudice to change the phrase "the medium" to --a medium--, thereby obviating the present rejection.

Withdrawal of this rejection is therefore respectfully requested.

III. Rejection of Claims 14 and 16 to 27 Under 35 U.S.C. § 112, First Paragraph

Claims 14 and 16 to 27 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. It is respectfully submitted that the present rejection should be withdrawn for at least the following reasons.

The Office Action's conclusory assertions at page 2 do not constitute a proper enablement analysis. It is respectfully submitted that the Office Action's assertions and arguments presented do not reflect the standard for determining whether a patent application complies with the enablement requirement that the specification describe how to make and use the invention -- which is defined by the claims. (See M.P.E.P. § 2164). The Supreme Court established the appropriate standard as whether any experimentation for practicing the invention was undue or unreasonable. (See M.P.E.P. § 2164.01 (citing Mineral Separation v. Hyde, 242 U.S. 261, 270 (1916); In re Wands, 858 F.2d. 731, 737, 8 U.S.P.Q.2d 1400, 1404

(Fed Cir. 1988))). Thus, it is axiomatic that the enablement test is "whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." (See id. (citing United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988))).

The Federal Circuit has made clear that there are many factors to be considered in determining whether a specification satisfies the enablement requirement, and that these factors include but are not limited to the following: the breadth of the claims; the nature of the invention; the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. (See id. (citing In re Wands, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407)). In this regard, the Federal Circuit has also stated that it is "improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors," and that the examiner's analysis must therefore "consider all the evidence related to each of these factors" so that any nonenablement conclusion "must be based on the evidence as a whole." (See M.P.E.P. § 2164.01).

Also, an examiner bears the initial burden of establishing why the "scope of protection provided by a claim is not adequately enabled by the disclosure." (See id. (citing In re Wright, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993))). Accordingly, a specification that teaches the manner and process of making and using an invention in terms that correspond in scope to those used in describing and defining the claimed subject matter complies with the enablement requirement. (See id.).

In contrast to the above, however, it is respectfully submitted that the Office Action's unsupported assertions simply do not concern — as they must under the law — whether the present application enables a person having ordinary skill in the art to practice the claimed subject matter of the claims without undue experimentation — which it plainly does, as would be understood by a person having ordinary skill in the art in view of the disclosure of the present application, including the specification. In short, the Office Action's assertions are merely conclusory and do not address the issue of whether one having ordinary skill would have to unduly experiment to practice the claimed subject matter of the rejected claims — *a*

proposition for which the Office bears the burden of proving a prima facie case as to the rejected claims.

In this regard, to properly establish enablement or non-enablement, the Office must make use of proper evidence, sound scientific reasoning and the established law. In the case of Ex Parte Reese, 40 U.S.P.Q.2d 1221 (Bd. Pat. App. & Int. 1996), a patent examiner rejected (under the first paragraph of section 112) application claims because they were based on an assertedly non-enabling disclosure, and was promptly reversed because the rejection was based only on the examiner's subjective belief that the specification was not enabling as to the claims. In particular, the examiner's subjective belief was simply not supported by any "evidence or sound scientific reasoning" and therefore ignored recent case law — which makes plain that an examiner (and not an applicant) bears the burden of persuasion on an enablement rejection.

More particularly, the examiner in Ex parte Reese was reversed because the rejection had only been based on a conclusory statement that the specification did not contain a sufficiently explicit disclosure to enable a person to practice the claimed invention without exercising undue experimentation — which the Board found to be merely a conclusory statement that only reflected the subjective and unsupported beliefs of a particular examiner and that was not supported by any proper evidence, facts or scientific reasoning. (See id.). *Moreover, the Board made clear that it is "incumbent upon the Patent Office . . . to back up assertions of its own with acceptable evidence," and also made clear that "[where an] examiner's 'Response to Argument' is not supported by evidence, facts or sound scientific reasoning, [then an] examiner has not established a prima facie case of lack of enablement under 35 U.S.C. § 112, first paragraph.*" (See id. at 1222 & 1223).

In the present case, the Office Action has not established – even in a conclusory manner -- that undue experimentation would be required.

In addition, on page 7, lines 14 to 17, of the specification, reference is made to the fact that the method according to the present invention is not exclusively restricted to an electrochemical process having an electrolyte as a working medium. It is also conceivable to use it in a galvanic, electro-erosive, or spark-erosive process. The functioning is identical, with the difference that depending on the process, a working medium other than an electrolyte is to be used. However, the

suitable, process-dependent working media are known to one skilled in the art. Thus, the ability to implement the method according to the present invention in a non-electrochemical process would be understood by one skilled in the art.

In view of the foregoing, it is respectfully submitted that claims 14 and 16 to 27 are sufficiently enabled. Accordingly, withdrawal of this rejection is respectfully requested.

IV. Rejection of Claims 14 to 16, 18, 19, and 24 Under 35 U.S.C. § 102(b)

Claims 14 to 16, 18, 19, and 24 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,225,053 ("Frembgen"). It is respectfully submitted that Frembgen does not anticipate these claims for at least the following reasons.

Claim 14, as amended, relates to a method for processing at least one workpiece according to an electrochemical processing, including the features of increasing the voltage prior to a significant processing of the at least one workpiece, the voltage then being increased via a ramp to a predefined value, at which the significant processing will then occur. Support for this amendment may be found, for example, on page 5, lines 11 to 17, and page 6, lines 12 to 15, of the specification.

Frembgen is directed to a method for controlling an electrical current from a direct current source of an electrochemical working machine having a tool and a workpiece, wherein the electrical current is continuously increased to the working gap as a function of the physical parameter measured such that the gap voltage is continuously increased as the spacing of the working gap is increased.

According to Fremdgen, the ramp-shaped voltage characteristic occur exclusively at the time of a processing. Nowhere, does Frembgen disclose, or even suggest, a point in time prior to which no significant processing takes place. According to Figure 4 of Fremdgen, a sudden application of the working voltage to 12V is to be assumed. In Fremdgen, the focus is on a reduction of the processing time. Thus, one skilled in the art would not increase the voltage in a ramp-shaped manner to a value U1, at which time a significant processing of the workpiece takes place.

In contrast, according to the present invention, the ramp-shaped voltage characteristic is configured such that when value U1 is reached, ***a significant processing*** of the workpiece takes place. Thus, the method according

to the present invention also covers a time period ***before*** the actual processing of the workpiece. The present invention is based on the knowledge that when the processing voltage is applied suddenly with the switch-on phase, a very high processing current flows, which can cause damage to the electrode, at least over the long term (*see* page 2, lines 18 to 22, of the specification). As a result, initial current spikes are eliminated, and the switch-on phase for processing the workpiece occurs in a much smoother manner. Accordingly, the ramp guides the entire system in a gentle manner from a non-processing state to a processing or removing state.

As such, Frembgen does not disclose, or even suggest, all of the features recited in claim 14. Therefore, it is respectfully submitted that Frembgen does not anticipate claim 14.

Claims 15, 16, 18, 19, and 24 ultimately depend from claim 14 and therefore include all of the features recited in claim 14. As such, it is respectfully submitted that Frembgen does not anticipate these dependent claims for at least the reasons set forth above in support of the patentability of claim 14.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

V. Rejection of Claim 17 Under 35 U.S.C. § 103(a)

Claim 17 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Frembgen and U.S. Patent Application Publication No. 2003/0155255 ("Yahalom et al."). It is respectfully submitted that the combination of Frembgen and Yahalom et al. does not render unpatentable this claim for at least the following reasons.

As an initial matter, it is noted that U.S. Patent Application Publication No. 2003/0155255 does not appear to constitute prior art against the present application. In this regard, U.S. Patent Application Publication No. 2003/0155255 indicates that it published from U.S. Patent Application Serial No. 10/188,163, which was filed on ***July 1, 2002***. The present application claims priority to German Patent Application No. 102 14 618.7, which was filed on ***April 3, 2002***. The Office Action Summary acknowledged receipt of a copy of the certified copy of the priority document from the International Bureau, and a certified English-language translation of the priority document is submitted herewith. Although U.S. Patent Application Publication No. 2003/0155255 refers on its face to U.S. Provisional Patent

Application No. 60/350,876 ("the '876 provisional application"), filed on January 22, 2002, the subject matter of U.S. Patent Application Publication No. 2003/0155255 relied upon in the Office Action does not appear to be included in the '876 provisional application. Thus, the January 22, 2002 filing date of the '876 provisional application is entirely irrelevant to the present rejection. For the convenience of the Examiner, a copy of the '876 provisional application is submitted herewith and is cited in the Information Disclosure Statement filed herewith.

Moreover, claim 17 depends from claim 14 and therefore includes all of the features included in claim 14. As more fully set forth above, Frembgen does not disclose, or even suggest, all of the features included in claim 14. Yahalom et al. is not relied upon for disclosing or suggesting the features of claim 14 not disclosed or suggested by Frembgen. Indeed, it is respectfully submitted that Yahalom et al. does not disclose, or even suggest, the features included in claim 14 not disclosed or suggested by Frembgen. As such, it is respectfully submitted that the combination of Frembgen and Yahalom et al. does not render unpatentable claim 17, which depends from claim 14.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

VI. Rejection of Claim 20 Under 35 U.S.C. § 103(a)

Claim 20 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Frembgen in view of U.S. Patent No. 6,551,488 ("Hey et al.") or U.S. Patent No. 5,004,528 ("England"). It is respectfully submitted that the combination of Frembgen and Hey et al. or England does not render unpatentable this claim for at least the following reasons.

Claim 20 depends from claim 14 and therefore includes all of the features included in claim 14. As more fully set forth above, Frembgen does not disclose, or even suggest, all of the features included in claim 14. Hey et al. or England are not relied upon for disclosing or suggesting the features of claim 14 not disclosed or suggested by Frembgen. Indeed, it is respectfully submitted that Hey et al. or England do not disclose, or even suggest, the features included in claim 14 not disclosed or suggested by Frembgen. As such, it is respectfully submitted that the combination of Frembgen and Hey et al. or England does not render unpatentable claim 20, which depends from claim 14.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

VII. Rejection of Claim 21 Under 35 U.S.C. § 103(a)

Claim 21 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Frembgen in view of U.S. Patent No. 3,635,802 ("Manning et al."). It is respectfully submitted that the combination of Frembgen and Manning et al. does not render unpatentable this claim for at least the following reasons.

Claim 21 depends from claim 14 and therefore includes all of the features included in claim 14. As more fully set forth above, Frembgen does not disclose, or even suggest, all of the features included in claim 14. Manning et al. is not relied upon for disclosing or suggesting the features of claim 14 not disclosed or suggested by Frembgen. Indeed, it is respectfully submitted that Manning et al. does not disclose, or even suggest, the features included in claim 14 not disclosed or suggested by Frembgen. As such, it is respectfully submitted that the combination of Frembgen and Manning et al. does not render unpatentable claim 21, which depends from claim 14.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

VIII. Rejection of Claim 23 Under 35 U.S.C. § 103(a)

Claim 23 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Frembgen in view of U.S. Patent No. 5,503,730 ("Osano et al."). It is respectfully submitted that the combination of Frembgen and Osano et al. does not render unpatentable this claim for at least the following reasons.

Claim 23 depends from claim 14 and therefore includes all of the features included in claim 14. As more fully set forth above, Frembgen does not disclose, or even suggest, all of the features included in claim 14. Osano et al. is not relied upon for disclosing or suggesting the features of claim 14 not disclosed or suggested by Frembgen. Indeed, it is respectfully submitted that Osano et al. does not disclose, or even suggest, the features included in claim 14 not disclosed or suggested by Frembgen. As such, it is respectfully submitted that the combination of Frembgen and Osano et al. does not render unpatentable claim 23, which depends from claim 14.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

IX. Rejection of Claims 22, 25, 26 Under 35 U.S.C. § 103(a)

Claims 22, 25, 26 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Frembgen in view of U.S. Patent No. 6,214,200 ("Altena et al."). It is respectfully submitted that the combination of Frembgen and Altena et al. does not render unpatentable these claims for at least the following reasons.

Claims 22, 25, 26 depend from claim 14 and therefore include all of the features included in claim 14. As more fully set forth above, Frembgen does not disclose, or even suggest, all of the features included in claim 14. Altena et al. is not relied upon for disclosing or suggesting the features of claim 14 not disclosed or suggested by Frembgen. Indeed, it is respectfully submitted that Altena et al. does not disclose, or even suggest, the features included in claim 14 not disclosed or suggested by Frembgen. As such, it is respectfully submitted that the combination of Frembgen and Altena et al. does not render unpatentable claims 22, 25, 26, which depend from claim 14.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

X. Rejection of Claim 27 Under 35 U.S.C. § 103(a)

Claim 27 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Frembgen in view of Altena et al. or U.S. Patent No. 6,440,291 ("Henri et al."). It is respectfully submitted that the combination of Frembgen and Altena et al. or Henri et al. does not render unpatentable this claim for at least the following reasons.

Claim 27 depends from claim 14 and therefore includes all of the features included in claim 14. As more fully set forth above, Frembgen does not disclose, or even suggest, all of the features included in claim 14. Altena et al. or Henri et al. are not relied upon for disclosing or suggesting the features of claim 14 not disclosed or suggested by Frembgen. Indeed, it is respectfully submitted that Altena et al. or Henri et al. do not disclose, or even suggest, the features included in claim 14 not disclosed or suggested by Frembgen. As such, it is respectfully

submitted that the combination of Frembgen and Altena et al. or Henri et al. does not render unpatentable claim 27, which depends from claim 14.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

XI. New Claim 28

New claim 28 has been added. It is respectfully submitted that new claim 28 adds no new matter and is fully supported by the present application, including the Specification. Since claim 28 depends from claim 14, it is respectfully submitted that new claim 28 is allowable for at least the reasons more fully set forth above with respect to claim 14.

XII. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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